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OFFICE OF PETITIONS

In re Application of
Russel D. Leatherman et al.
Application No. 09/500,094
Filed: February 8, 2000
Attorney Docket No. 2400-505

DECISION GRANTING
PETITION

This is a decision on the paper titled "Petition under 37 C.F.R. § 1.47(a) and 37 C.F.R. § 1.131(a) to Accept Declaration under 37 C.F.R. § 1.131 without Signature of Russel D. Leatherman," filed March 24, 2003, which is being treated as a § 1.183 waiver of § 1.131's requirement that all of the inventors sign the declaration of prior inventorship.

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on February 8, 2000. At the time of filing, applicants submitted a 37 CFR 1.63 declaration from a prior application signed by all of the inventors. Non-final Office actions were mailed September 27, 2001 and May 7, 2002. A final Office Action was mailed on November 8, 2002. This office action set a shortened statutory period for reply of three months, with extensions of time obtainable under 37 CFR 1.136(a).

In response, on March 24, 2003, applicants submitted an Request for Continued Examination (RCE) in response, including a declaration under 37 CFR 1.131. This reply was made timely by an accompanying petition and fee for extension of time for response within the second month. The 37 CFR 1.131 declaration states that all of the inventors were responsible for reduction to practice of the subject matter of the rejected claims prior to the date of the reference on which the November 8, 2002 rejection was based. The 37 CFR 1.131 declaration was signed by all of the joint inventors, except inventor Leatherman. Applicant has filed the instant petition to have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventor Leatherman. Petitioner asserts that inventor Leatherman is either unwilling or unavailable to execute the declaration.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an

¹ 37 CFR 1.47 only applies when an inventor refuses to sign the original 37 CFR 1.63 oath or declaration.

appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.²

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."³

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicants do not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR 1.183 to be granted to waive this requirement that joint inventor Leatherman sign the § 1.131 declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On instant petition, applicants have set forth the steps taken to obtain joint inventor Leatherman's signature on the § 1.131 declaration. Applicants have shown that a *bona fide* effort was made to present the § 1.131 declaration and supporting documentation to inventor Leatherman for signature, to reach inventor Leatherman by email to discuss his failure to execute the declaration, and that by his conduct, inventor Leatherman has refused to execute the declaration. The declaration presented is signed by joint inventor Royal. Under the circumstances, it is concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

The 37 CFR 1.131 declaration may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied.

The application file is being forwarded to Technology Center 3600 for consideration on the merits of the reply and the 37 CFR 1.131 declaration, filed March 24, 2003.

Telephone inquiries concerning this decision should be directed to the undersigned Petitions Attorney at (703) 305-4497.



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² 37 CFR 1.131(a) (emphasis added).

³ MPEP 715.04.